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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,374	10/12/2000	James W. Brinsfield	GEMS8081.041	8236
27061	7590	05/13/2005	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)			PORTER, RACHEL L	
14135 NORTH CEDARBURG ROAD			ART UNIT	
MEQUON, WI 53097			PAPER NUMBER	

3626

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/689,374

Applicant(s)

BRINSFIELD ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 13 April 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


JOSEPH THOMAS

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Applicant's arguments filed 4/13/05 have been fully considered but they are not persuasive.

(A) Applicant argues that the Maschke reference does not disclose the wireless local area network (WLAN) as claimed by the Applicant.

Maschke discloses that multiple components of the patient monitoring computer system transmit data via wireless communication, as cited in the art rejected provided in the Non-Final and Final rejections (see especially col. 3, lines 21-44).

While the Applicant cited portions from the Applicant's specification in an attempt to distinguish the wireless communication in the cited reference from that claimed in the instant invention in the Response to the Non-Final Rejection received 10/4/04, it is noted that the cited passage does not set forth a clear or specific definition for a WLAN (See also *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); MPEP 2111.01).

Instead, the passage merely provides examples of various entities, which may communicate via a WLAN. In the absence of such a definition, the Examiner must give the term the broadest reasonable interpretation (e.g. wireless communication between 2 or more computer components) and provide art accordingly. (See Final Rejection mailed 1/13/2005)

(B) As to the Applicant's arguments regarding the silencing an alarm, the applicant fails to consider the combined teachings of Maschke in view of Fuchs.

Maschke teaches a patient monitoring system (and computer program for operating the system) that includes the use of patient alarms. Fuchs discloses patient monitoring systems that sound alarms when a patient alarm (e.g. emergency) occurs and further discloses that patient monitoring systems often enable remote silencing of bedside patient alarms. (col. 1, lines 19-34) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Maschke with the teaching of Fuchs to provide alarms when patients experience emergencies and to allow the user to remotely silence patient bedside alarms. As suggested by Fuchs, one would have been motivated to include these features to reliably inform the staff of medical emergencies associated with the patients (col. 1, lines 59-63), while minimizing noise disruption for the patient. (See Paragraph 14(E) Final Rejection mailed 1/13/2005)

(C) The Applicant challenged the Examiner's statement that the use of voice-over-Internet Protocol was well known in the art at the time of the Applicant's filing and further argued that the Examiner relied upon improper hindsight.

In response, the Examiner has provided references to support the Official Notice statement put forth in the Non-Final and Final Rejection. Gallant et al (USPN 6,705,990) discloses a patient monitoring system, which transmits data via using a plurality of networks (e.g. LAN's, WAN's). The Gallant reference further discloses that at the time of the disclosed invention, voice-over internet protocol (VoIP) was a well known method used to transmit (voice) data (col. 21, lines 24-29). Kaffine et al (USPN 6,654,914) further discloses the use of VoIP prior to the filing date of the instant application (col. 9, lines 37-49).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

However, it is noted that in the present case, Examiner provided references to support the use of Official Notice and to show that Voice-over Internet Protocol was in fact well-known at the time of the Applicant's invention. Moreover, the Examiner has provided motivation from a secondary reference to make a modification to the prior art teachings to include the use of VOIP and to support the holding of obviousness.

(See paragraph 14(C) of Final Rejection mailed 1/13/2005 and Advisory action mailed 4/4/2005.)

(D) Applicant argues that Maschke does not teach transmitting care parameters to the "data acquisition modules," fails to disclose a WLAN, and therefore does not address the limitations of claim 18.

The Applicant's arguments regarding the WLAN have been addressed in the Final Rejection, the Advisory Action mailed 4/4/05, and have been further addressed in paragraph 1(A) of the present Office Action.

In response to applicant's argument that the Maschke reference fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "transmitting care parameters to the data acquisition modules,") are not recited in the rejected claim(s)). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, it is noted that the Applicant relies upon tentative claim language (e.g. "having a configuration to allow wireless transport on a health care provider...") rather positive recitations to further define the features/ functionality of the portable patient monitor and the mobile clinical system.

For example, it should be noted that the current wording of the claim is ambiguous and suggests an intended use for a communication interface or the patient monitor. The first part of the current language may be interpreted as having a patient monitor that has a processor and is connected to a communication interface. It is not clear whether the communication interface is a separate element of the claimed system, as it is not separately listed among the system components. Also, it is not entirely clear whether the intended functionalities of "to receive and process patient data and to process and transmit care parameters..." are supposed to be performed by the patient monitor having a processor or the communication interface, or whether these functions are actually performed at all.

Moreover, it should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).